



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,211	01/17/2007	Yasutoshi Kawaguchi	OKUDP0163US	7642
51921 7590 08/05/2009 MARK D. SARALINO (PAN) RENNER, OTTO, BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE 19TH FLOOR CLEVELAND, OH 44115				
EXAMINER SAYADIAN, HIRAYR				
ART UNIT 2814		PAPER NUMBER		
MAIL DATE 08/05/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/573,211

Applicant(s)

KAWAGUCHI ET AL.

Examiner

HRAIR A. SAYADIAN

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED OFFICE ACTION

The 4/29/2009 Office Action Is Withdrawn

1. The 4/29/2009 "Office Action" is hereby withdrawn.

The 5/27/2009 Reply responding to the Office Action is noted. The Office Action inadvertently applied U.S. national restriction practice, not noting that this application is a 371 off of a PCT. Accordingly, the Office Action improperly explained the restriction required and therefore is withdrawn.

A shortened statutory period for reply to this Office Action is set to expire **ONE MONTH** from the mailing date of this Office Action.

Restriction Requirement Based on Lack of Unity

2. Applicant is required under PCT Rules 13.1-13.4 (See M.P.E.P. § 1850) to elect one of the following groups of claims for prosecution on the merits.

Group I. Claims 1, 2, 3, 10-12, 15, 17

Group II. Claims 1, 2, 4-12, 15, 16

Group III. Claims 1, 2, 10-15

Groups I-III lack "special technical feature" under PCT Rules 13.1-13.4 as evidenced by U.S. Pat. No. 5,777,350 to "Nakamura." For example, the front page of Nakamura discloses the features recited in claim 1. And because the second p-type nitride layer has a higher bandgap it functions as a barrier layer. And Nakamura discloses the material of element 15 to be GaN, which therefore has a bandgap less than GaAlN and which can also function as a cladding.

A complete reply to this requirement must:

1. elect an invention to be examined even though the requirement may be traversed (37 CFR § 1.143); and

2. **list all claims reading on the elected invention, including any claims subsequently added.**

An argument that all claims are allowable, or that the requirement is in error, is nonresponsive unless accompanied by an election. See, for example, M.P.E.P § 818.03(b).

To preserve a right to petition under 37 CFR § 1.144, Applicant must elect with traverse. See, for example, M.P.E.P. § 818.03(c). An untimely traversal loses the right to petition under 37 CFR § 1.144. A traversal must be presented at the time of election to be considered timely.

If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. See, for example, M.P.E.P § 818.03(a).

Should Applicant traverse on the ground that the inventions are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other invention.

If claims are added after the election, Applicant must indicate which of these claims are readable on the elected invention. See M.P.E.P. § 809.02(a).

Upon the cancellation of claims to a non-elected invention, Applicant must amend the inventorship complying with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Amending inventorship must be accompanied by a request under 37 CFR § 1.48(b) and include the fee required under 37 CFR § 1.17(i).

CONCLUSION

3. A shortened statutory period for reply to this Office Action is set to expire **ONE MONTH** from the mailing date of this Office Action. Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

Any inquiry concerning this communication or earlier communications from an Examiner should be directed to Examiner Hrayr A. Sayadian, at (571) 272-7779, on Monday through Friday, 7:30 am – 4:00 pm ET.

If attempts to reach Mr. Sayadian by telephone are unsuccessful, his supervisor, Supervisory Primary Examiner Wael Fahmy, can be reached at (571) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available only through Private PAIR. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. The Electronic Business Center (EBC) at 866-217-9197 (toll-free) may answer questions on how to access the Private PAIR system.

/Hrayr A. Sayadian/

Patent Examiner, Art Unit 2814